

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
PATENT EXAMINING OPERATION

PATENT

Applicant(s): Maria Elena de Lima PEREZ-GARCIA

Serial No: 10/517,097

Group Art Unit: 1653

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Examiner: Shawn A. Hamidinia

Att. Docket No.: B1204/20002

Confirmation No.: 5628

For: SCORPION PEPTIDE AS HYPOTENSIVE AGENT

PROVISIONAL ELECTION IN RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the restriction requirement set forth in the January 24, 2006 Office Action, Applicants hereby provisionally elect Group I, claims 1 and 3, drawn to an isolated or synthetic polypeptide sequence comprising a member selected from the group consisting of SEQ ID NO: 1, SEQ ID NO:2, SEQ ID NO:3 and SEQ ID NO:4. This provisional election is made with traverse.

This application is a U.S. national stage application of PCT/BR03/00073, which was filed under 35 U.S.C. § 371. As noted in MPEP 1893.03(d), "unity of invention (not restriction) practice is applicable in . . . national stage applications submitted under 35 U.S.C. 371." Although the Office Action purports to apply unity of invention rules in Paragraph 2, only claim 3 is addressed. Assuming for the sake of argument that the Examiner is correct that claim 3 does not share a special technical feature with the claims of the other groups, this does not justify restriction of the claims into seven different groups. The Examiner has not even attempted to show that there is no special technical feature shared by claims 1-2 and 4-9.

Moreover, the stated reason that claim 3 lacks a special technical feature is that a partial portion of the specified sequences could mean a single amino acid, and single amino acids are known in the art. However, claim 3 is directed to an isolated or synthetic peptide, wherein the peptide is an anti-hypertensive agent. Peptides are not single amino acids. The stated basis for the restriction is technically incorrect, and the restriction should be withdrawn.

The claims share special technical features as noted below.

Claims 1 and 3 share the special technical feature of an isolated or synthetic peptide comprising at least a portion of SEQ ID NO:1; SEQ ID NO:2; SEQ ID NO:3 or SEQ ID NO:4.

Claim 4 is a nucleic acid molecule encoding the peptide of claim 1. Nucleic acids and the peptides they encode exhibit unity of invention. See, e.g., Chapter 10 of the PCT International Search and Preliminary Examination Guidelines at Example 39, which is cited as authority in MPEP 1850.

Claim 5 is simply a product-by-process claim dependent from claim 1, and should not be restricted from it. Both still relate to the special technical feature of an isolated or synthetic peptide comprising SEQ ID NO:1; SEQ ID NO:2; SEQ ID NO:3 or SEQ ID NO:4.

Claim 6 is directed to a method of making a composition including the special technical feature of claim 1.

Claim 7 is directed to a method of making excipients or vectors for the special technical feature of claims 1 and 3.

Claim 8 is directed to a composition including the special technical feature of claim 1.

Claim 9 is directed to a method of using the special technical feature of claim 1.

Accordingly, reconsideration and withdrawal of the restriction requirement are respectfully requested.

Should the Examiner believe that anything further is desirable in order to place the application in even better condition for initial examination and allowance, the Examiner is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,

CAESAR, RIVISE, BERNSTEIN,
COHEN & POKOTILOV, LTD.

March 24, 2006

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Please charge or credit our
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